

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Edward J. Stashluk Jr. et al.
Serial No.: 10/775,368
Filing Date: February 10, 2004
Group Art Unit: 3689
Examiner: Thuy-Vi Thi Nguyen
Confirmation No.: 9915
Title: COMPUTER GENERATED MERCHANDISE
RETURN LABELS WITH RULES-BASED CODING

Mail Stop Notice of Appeal
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action dated January 20, 2011 (the "*Office Action*") and the Advisory Action dated April 7, 2011 (the "*Advisory Action*"), to establish a *prima facie* rejection of Appellants' pending claims. Appellants respectfully seek review of the rejections of independent Claims 1, 14, and 28. Appellants do not currently seek review of Claims 2-13, 15-27, 29-32, and 33-35.

ARGUMENTS

In the *Final Office Action*, all pending claims were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Application Publication No. 2002/0013744 issued to Tsunenari et al. ("*Tsunenari*") in view of U.S. Patent No. 6,015,167 issued to Savino et al ("*Savino*") and further in view of Official Notice. Applicants respect traverse these rejections

Independent Claim 1 of the present Application recites, *inter alia*:

. . . using the computer operated by the merchant . . . to generate a first machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represented by the first machine readable code comprises a plurality of data points, at least a first of the plurality of data points included in the first machine readable code representing at least the shipping origin of the package and at least a second data point in the first machine readable code representing the identification of the transaction;

. . . using the computer operated by the merchant . . . to format the return shipping label, such that the return shipping label contains the first machine readable code and complies with shipping label specifications of the choice of carrier, the first machine readable code not associated with the carrier and in addition to a second carrier-specified machine readable code also present on the shipping label . . .

Thus, Applicants' claim relates to the generation of a return shipping label that "complies with the shipping label specifications of the choice the carrier" and includes both "a first machine readable code" and a "second carrier-specified machine readable code." Applicants' claims further requires that the first machine readable code is "not associated with the carrier" but that the shipping label still "complies with shipping label specifications of the choice of carrier." Whether considered alone or in combination, *Tsunenari* and *Savino* do not disclose, either expressly or inherently, each and every element of the claims.

To reject the claims, the Examiner relies upon *Tsunenari* for disclosure of "the return shipping label" having a "carrier-specified machine readable code" but acknowledges that *Tsunenari* does not disclose an additional machine readable code that represents at least the shipping origin of the package and the identification of the transaction. (*Office Action*, pages 6 and 14-15; *Advisory Action*, page 2). To make up for the deficiencies of *Tsunenari*, the Examiner points to *Savino* for disclosure of the "machine readable code" that is not

associated with the carrier. (*Office Action*, pages 6-7 and 15; *Advisory Action*, page 2). Applicants respectfully disagree.

Applicants submit that *Tsunenari* discloses a typical carrier shipping label. (*Tsunenari*, paragraphs 62 and 81). In contrast, *Savino* does not at all relate to a shipping label that is included on the outside of a package. Rather, though *Savino* uses the term “shipping label,” the background portion of *Savino* makes clear that a “shipping label” is merely a “packing slip” or something analogous to a packing slip. (*Savino*, Column 1, lines 36-50; Figures 3 and 5). Additionally, *Savino* describes that the label includes “a single bar code” that is “linked with purchase and shipping information associated with a purchase order.” (*Savino*, Column 2, lines 7-10). With regard to the label, *Savino* states:

The shipping label includes a single-block bar code 102 which when scanned accesses the scanning system to a plurality of predetermined relevant purchase and shipping information associated with a purchase order which is stored in the supplier database 14 or digital processor 12. A “trigger number” 104 provides an alternative means for accessing the purchase and shipping information provided by the bar code 102. The shipping label 100 may also list some of the purchase and shipping information such as, for example, a customer purchase order number 106, a box quantity number 108, a part quantity number 110 and a customer part number 112.

(*Savino*, column 3, lines 48-61). Thus, though the label is termed a “shipping label” it is not a carrier label and has none of the usual features of a shipping label. Rather, the label merely includes the bar code identifying a packing slip number and printed matter that relates to the customer purchase order no., the number of boxes, the quantity, and the customer part number (*Savino*, Figure 3). Accordingly, neither *Tsunenari* nor *Savino* disclose a return shipping label that “complies with shipping label specifications of the choice of carrier” and includes both “the first machine readable code not associated with the carrier” and “a second carrier-specified machine readable code also present on the shipping label,” as recited in Claim 1.

The Examiner answers that “the instant claim language failed to provide specific structure and functional distinction between the claimed “shipping label” and that of *Tsunenari/Savino*.” (*Office Action*, page 17; *Advisory Action*, page 2). Applicants respectfully disagree. Applicants’ Claim 1 recites “using the computer . . . to generate a

machine readable code **for the return shipping label for shipment from the customer to the returns center.**” As such, Applicants claims do recite specific structure and functional distinction between the claimed “shipping label” and the labels disclosed in *Tsunenari* and *Savino*. Neither reference nor their proposed combination discloses a return shipping label that “complies with the shipping label specifications of the choice the carrier” and includes both “a first machine readable code” and a “second carrier-specified machine readable code.”

Furthermore, Applicants respectfully submit that the proposed *Tsunenari-Savino* combination is improper. In the *Office Action*, the Examiner states that “it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label of *Tsunenari* to include the shipping label contains the machine readable code which represents customer address and identification of the transaction as taught by *Savino et al* for coordinating shipping and receiving information between supplier/merchant and customers in order to reduce the time consuming and costly.” (*Office Action*, page 6-8). It remains Applicants’ position, however, that *Savino* teaches away from the proposed combination.

Savino specifically relates to a “**single** bar code shipping label.” (*Savino*, Column 2, lines 7-10, emphasis added). Throughout, *Savino* praises a label that includes a **single** bar code. According to *Savino*, “if for example, nine bar codes are provided with each packing slip, it will typically take about one minute to scan-in each nine-block label.” (*Savino*, Column 1, lines 43-45). As another example, *Savino* explains that “several bar codes increases the likelihood that one or more of the bar codes provides incorrect information.” (*Savino*, Column 1, lines 48-50). With regard to previous packing slips, *Savino* discloses that a “drawback is that the packing slip supplied with each purchase order typically includes several bar codes that are scanned by the customer if equipped with an automated receiving system.” (*Savino*, Column 1, lines 36-38). Thus, *Savino* actually teaches away from a shipping label that includes more than one bar code. As a result, *Savino* teaches away from modifying the carrier-specific bar code of *Tsunenari* to include an additional merchant-specific bar code. Even if the proposed combination can be properly made (which Applicants respectfully dispute), the proposed combination merely results in a package having a first shipping label with a carrier-specific bar code (such as that disclosed in *Tsunenari*) and a second packing slip type label with an additional machine readable code (such as that disclosed in *Savino*). The proposed combination does not disclose “the return shipping label

contains the first machine readable code and complies with shipping label specifications of the choice of carrier, the first machine readable code not associated with the carrier and in addition to a second carrier-specified machine readable code also present on the shipping label," as recited in Claim 1.

For at least these reasons, Applicants submit that the rejection of independent Claim 1 is improper and should be withdrawn. For analogous reasons, Applicants submit that the rejections of independent Claims 14 and 28 are also improper and should be withdrawn.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicant respectfully requests full allowance of all pending Claims.

Applicant believes no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Date: April 20, 2011

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